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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,260	07/24/2003	Robert Greenberg	S202-USA	7590

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SECOND SIGHT MEDICAL PRODUCTS, INC.
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EXAMINER

GETTMAN, CHRISTINA DANIELLE

ART UNIT	PAPER NUMBER
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3734

MAIL DATE	DELIVERY MODE
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02/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/627,260

Applicant(s)

GREENBERG ET AL.

Examiner

CHRISTINA D. GETTMAN

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Drawings

Figures 8-11 are objected to under 37 CFR 1.84(m). The use of shading in views is encouraged if it aids in understanding the invention and if it does not reduce legibility. Shading is used to indicate the surface or shape of spherical, cylindrical, and conical elements of an object. Flat parts may also be lightly shaded. Such shading is preferred in the case of parts shown in perspective, but not for cross sections. See paragraph (h)(3) of this section. Spaced lines for shading are preferred. These lines must be thin, as few in number as practicable, and they must contrast with the rest of the drawings. As a substitute for shading, heavy lines on the shade side of objects can be used except where they superimpose on each other or obscure reference characters. Light should come from the upper left corner at an angle of 45°. Surface delineations should preferably be shown by proper shading. **Solid black shading areas are not permitted, except when used to represent bar graphs or color.**

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the top portion and base portion having curved surfaces facing outward and flat on surfaces facing each other must be shown or the feature(s) canceled from the claim(s). Also, the base portion having an outer surface that is concave in one dimension and convex in another dimension and an inner surface being convex in one direction and flat in another must be shown or the feature(s) canceled from the claim(s). Even further, the top portion having an outer surface that is convex in two dimensions and an inner surface that is

concave in one dimension and flat in another dimension must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 12, and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is unclear where in the specification or in the drawings the end portion having a substantially hemispherical shape is located. It appears as though the end portions in Fig. 8-11 only show a curved end portion. There is not clear indication of a hemispherical shape since it does not appear that the sides of the end portion are rounded as well (i.e. to resemble a half of a ball). As such, *substantially hemispherical* is taken to mean a half of a ball in shape.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-4, 8, 11, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable by Aramant et al. (U.S. Patent No. 5,941,250) in view of Blake (U.S. Patent No. 6,280,449). Aramant et al. disclose a surgical tool (ref. 100) that has an end portion (ref. 110), a base portion (ref. 119) coupled to a back surface of the end portion, a top portion (ref. 118) coupled to the back surface at a different location than the base portion, the base portion being parallel to the top portion (see Fig. 9), the base and top portions being curved to radii where the portions are equally spaced from each other (see ref. 110, Fig. 9), the radii approximates the radius of an eye (see Fig. 5), the tool being made from a biocompatible elastic material (col. 5, lines 4-13), and the distance

between the portions being capable of holding an electrode array between them (the implant that is currently disclosed in the reference, ref. 120, could be replaced with an electrode array; therefore, the portions are capable of holding an electrode array between them). Aramant et al. do not disclose the end portion having a substantially hemispherical shape. Blake teaches an end portion (ref. 26) that can have a substantially hemispherical shape (col. 9, lines 30-31; flared portion can have a substantially hemispherical shape) that has a rounded front surface (col. 9, lines 27-29) and a back surface (ref. 24) opposite the front surface for the purpose of deploying an eye implant. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Aramant et al. with an end portion having a substantially hemispherical shape in order to have the tool form to the eye when inserting an implant into the eye. It is well-known to make flared portion have a more curved shape and, therefore, it would have been obvious to curve the flared portion of Aramant et al. to form an even more hemispherical shape.

Claims 2, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aramant et al. and Blake as applied to claim 1 above, and further in view of Tarrson et al. (U.S. Patent No. 4,925,073). Aramant et al. and Blake disclose the invention substantially as claimed except for a hinge connecting the top and base portion, a keeper connected to the base portion, or notches in the base. Aramant et al. and Blake also does not disclose the top portion and the base portion being two separate elements. However, *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully

met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose."). Tarrson et al. teach a holder with a base portion and top portion that are connected by a hinge for the purpose of opening and closing the tool, a keeper (ref. 86 and 88; keep the two portion from moving away from one another unless the keeper is moved) connected to the base portion for the purpose of preventing movement of the top portion, and a notch in the base for the purpose of mating with a guide on the top portion (ref. 86 and 88; act as a notch and guide). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Aramant et al. and Blake with a holder with a base portion and top portion that are connected by a hinge, as taught by Tarrson et al., in order to allow the tool to open to insert an implant and close to hold the implant, a keeper connected to the base portion, as taught by Tarrson et al., in order to prevent the top portion from moving away from the bottom portion, and a notch in the base, as taught by Tarrson et al., in order to allow the top and base portion to align with one another and stay closed.

Claims 5 and 9-10 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Aramant et al. and Blake, as applied to claims 1 and 8 above. Aramant et al. and Blake discloses the invention substantially as claimed except for the top portion and base portion being curved on surfacing facing outward and flat on surfaces facing each other as well as the tool being made out of ABS or elastic stainless steel. It would have

been obvious design choice to make the inner surfaces of the base and top portions in order to more securely hold the electrode array in-between the portions. This would also allow for even pressure to be applied across the array rather than unevenly applying pressure and possibly damaging the array. ABS and stainless steel are commonly used medical materials and it would, therefore, be obvious to have made the device of Hughes out of ABS or stainless steel in order to be used in the body.

Claims 12-16 and 19 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Aramant et al. in view of Blake. Aramant et al. disclose the invention substantially as claimed including providing a surgical tool (ref. 100) with an end portion (ref. 110), a base portion (ref. 119) coupled to a back surface of the end portion, a top portion (ref. 118) coupled to the back surface at a different location than the base portion, the base portion being parallel to the top portion (see Fig. 9), passing the surgical tool and implant into a body with the rounded front surface first (see Fig. 5), using the rounded front surface to separate extra ocular muscle (see ref. 110 pushing ref. 68), inserting the tool into the orbital socket (see Fig. 5), and releasing the implant from the tool once it is in the orbital socket (see Fig. 6). Aramant et al. do not disclose the end portion having a substantially hemispherical shape. Blake teaches an end portion (ref. 26) that can have a substantially hemispherical shape (col. 9, lines 30-31; flared portion can have a substantially hemispherical shape) that has a rounded front surface (col. 9, lines 27-29) and a back surface (ref. 24) opposite the front surface for the purpose of deploying an eye implant. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Aramant et

al. with an end portion having a substantially hemispherical shape in order to have the tool form to the eye when inserting an implant into the eye. It is well-known to make flared portion have a more curved shape and, therefore, it would have been obvious to curve the flared portion of Aramant et al. to form an even more hemispherical shape.

Claims 12-16 and 19 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Aramant et al. and Blake in view of Chow (EP 0460320 A1). Aramant et al. and Blake does not disclose the implant being an electrode. Chow teaches an electrode array being inserted into the retina (ref. 10 and ref. 78) for the purpose of stimulating the eye. It is also common for electrode arrays to have a cable coming off of them to be attached to other parts of the eye. Therefore, it would have been obvious to have modified the implant of Aramant et al. and Blake to be an electrode, as taught by Chow, in order to promote stimulation of the eye to increase eye sight. Aramant et al. and Blake also does not disclose inserting the tool into the orbital socket through a hole in the skull. However, this step of inserting a retinal implant is common practice. Therefore, it would have been obvious to have modified Aramant et al. and Blake with inserting the tool through the skull, as is known in the art, in order to prevent unnecessary damage to the eye.

Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aramant et al., Blake, and Chow, as applied to claim 12 above, and further in view of Tarrson et al. Aramant et al., Blake, and Chow disclose the invention substantially as claimed except for a hinge connecting the top and base portion and applying pressure to the two portion to retain the electrode array. Tarrson et al. teach a holder with a base

portion and top portion that are connected by a hinge for the purpose of opening and closing the tool and applying pressure to the two portion for the purpose of holding the electrode array (the container holds the inner piece inside by having the side walls apply pressure on the inner piece). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Aramant et al., Blake, and Chow with a holder with a base portion and top portion that are connected by a hinge, as taught by Tarrson et al., in order to allow the tool to open to insert an implant and close to hold the implant and applying pressure to the two portions, as taught by Tarrson et al., in order to prevent the implant from being prematurely released from the tool.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINA D. GETTMAN whose telephone number is (571)272-3128. The examiner can normally be reached on Monday-Thursday 6:45 am to 4:30 pm (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3731

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571-272-3128

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